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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,798	11/02/2001	William E. McLaughlin	01-4	1300

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EXAMINER

GABOR, OTILIA

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,798

Applicant(s)

MCLAUGHLIN, WILLIAM E.

Examiner

Otilia Gabor

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Specification

1. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the first copy is unreadable and the second copy is filled with underlines, notes, arguments, etc. which makes it very hard to read, understand and decipher what exactly is the disclosure. The claims contain two copies, one that has claims 4-6 and another containing claims 21-23, which is barely readable. The Applicant should present a clean and clear specification with the correct headings. Also the amendment should cancel the claims presented in the parent application.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Note: The preliminary amendment filed August 14, 2002 contains the erroneous Registration # 14,852 for Applicant's Representative John R. Ewbank.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

3. This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "This is a division of Application No. 09/235618, filed 01/21/1999." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of the parent nonprovisional application(s) should be included.

Note: The Applicant should cancel the lengthy explanation and arguments regarding the priority of this Application.

Drawings

4. The drawings in this application are objected to by the Draftsperson as informal. Any drawing corrections requested, but not made in the prior application should be repeated in this application if such changes are still desired. If the drawings were changed and approved during the prosecution of the prior application, a petition may be filed under 37 CFR 1.182 requesting the transfer of such drawings, provided the parent application has been abandoned. However, a copy of the drawings as originally filed must be included in the 37 CFR 1.60 application papers to indicate the original content.

Information Disclosure Statement

5. The information disclosure statement filed 11/02/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not list the date of publication of the cited reference as required. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

7. Claims 21-23 are objected to because of the following informalities: claim 21 contains periods after the wavelength units (i.e. 880nm., 1310nm., and 1550nm.); only one period indicating the end of the paragraph can be present in a claim; the word "wave length" is spelled many different ways; the Applicant should pick one and use it

throughout the claims (--wavelength--); the phrase "generating a laser beam having a wavelength corresponding to said components selectively responsive to such laser beam.." is grammatically incorrect; the terms "the feedback light" in line 8 and "the electrical signal" in line 9, "said feedback" in line 9 and "such feedback" in line 11 of claim 21 have no antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll et al. (U. S. Patent 5662534).

Kroll et al. discloses an apparatus and method for locating lost golf balls where the golf balls have a very thin metal foil vaporized on their surface in order to reflect back the radiation coming from the monitoring device. The monitoring device includes a battery 38 as the electric power source, which actuates a switching oscillator 60 and transistor 62 to send out the specific signal to which the metal foil on the surface of the ball is responsive to and it also includes a receptor oscillator to receive the feedback light which signal is then amplified by amplifier 68 and fed to a speaker 44. The speaker 44 is used to indicate by audio signal the varying intensity of the feedback signal thereby alerting the golfer that the ball is nearby.

Kroll et al. uses microwaves instead of the claimed wavelength range, however one of ordinary skill in the art would have been motivated to use the claimed wavelengths for as indicated in the invention the higher the frequency range of the radiation the better the reflection of the balls structure surface and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Castonguay et al. (U. S. Patent 6353386), Valentino (U. S. Patent 5132622), Baker (U. S. Patent 5370387).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Otilia Gabor whose telephone number is 703-305-0384. The examiner can normally be reached on Monday-Friday between 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 703-308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

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Art Unit: 2878

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April 24, 2003

Constantine Hannaher
CONSTANTINE HANNAHER
PRIMARY EXAMINER
GROUP ART UNIT 2878